REMARKS

Claims 1-14 were pending in this application.

Claims 1-14 have been rejected.

Claims 1, 8, and 14 have been amended as shown above. Because these amendments place Claims 1, 8, and 14 in better condition for allowance or appeal and do not require a new search, these amendments comply with 37 C.F.R. § 1.116.

Claims 1-14 remain pending in this application.

Reconsideration and full allowance of Claims 1-14 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-9 and 11-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,793,361 to Kahn et al. ("*Kahn*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Kahn recites a pointing interface for a display-based computer system. (*Abstract*). The

system includes multiple screens and hand-manipulated pointers that allow control of the various screens. (*Abstract; Figure 1*).

Regarding Claim 1, Claim 1 recites that a "parameter control command" includes "window identification information." The Office Action asserts that *Kahn* anticipates these elements of Claim 1. In particular, the Office Action notes that *Kahn* "select[s] an application based upon where the pointer is aimed and what actions/functions are activated by the user via the remote for the particular window." (*Office Action, Page 11, Fourth paragraph*). The Office Action then notes that *Kahn* "activates the appropriate window and action" based upon the position of the user's remote beam, so the beam identifies "the window to be activated/controlled." (*Office Action, Page 11, Fourth paragraph*).

These assertions in the Office Action do not establish that *Kahn* anticipates Claim 1. Claim 1 recites that "window selection means" select a window in response to a "parameter control command" received from a remote control, where the parameter control command includes "window identification information." The Office Action acknowledges that the system of *Kahn* selects a window based upon the position of a user's "remote beam." The Office Action cites no portion of *Kahn* as showing that the system of *Kahn* selects a window based on information contained in the actual beam from the user's pointer device. In particular, the Office Action does not show that *Kahn* selects a window based on "window identification information" contained in a "parameter control command" received from a remote control as recited in Claim 1. As a result, the Office Action fails to show that *Kahn* anticipates these elements of Claim 1.

Regarding Claim 8, Claim 8 recites that a display device includes "window means" for displaying information in "at least two windows in a display screen" and "window selection means" for selecting a window "in the display screen to be controlled." The Office Action has not shown that *Kahn* anticipates these elements of Claim 8.

Kahn simply recites that multiple "pointers" may be used with a display system and that the display system includes multiple "display screens." *Kahn* lacks any mention of allowing a user to select one of multiple windows and provide a command for that window, where the windows are in a single display screen. In particular, *Kahn* lacks any mention of "window means" for displaying information in at least two windows "in a display screen" and "window selection means" for selecting one of the windows "in the display screen" to be controlled as recited in Claim 8. As a result, the Office Action has not shown that *Kahn* anticipates all elements of Claim 8.

Regarding Claim 14, Claim 14 recites selecting "one of a plurality of windows in a display screen" and a "parameter control command" that includes "window identification information." As described above regarding Claims 1 and 8, the Office Action has not established that *Kahn* anticipates these elements of Claim 14. As a result, the Office Action has not shown that *Kahn* anticipates all elements of Claim 14.

For these reasons, the Office Action has not established that *Kahn* anticipates the Applicant's invention as recited in Claims 1, 8, and 14 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-9 and 11-14.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Kahn* in view of U.S. Patent No. 6,204,884 to Lee ("*Lee*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above in Section I, Claim 8 is patentable. As a result, Claim 10 is patentable due to its dependence from an allowable base claim.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claim 10.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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PATENT

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fee) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Feb. 10, 2004

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